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| 09/610,250      | 07/05/2000  | Barry Cavill         | LE9-00-043          | 4231             |

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EXAMINER

LEE, TOMMY D

|          |              |
|----------|--------------|
| ART UNIT | PAPER NUMBER |
|----------|--------------|

2624-

DATE MAILED: 06/05/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/610,250

Applicant(s)

CAVILL ET AL.

Examiner

Thomas D. Lee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent 5,361,134 (Hu et al.).

Hu et al. teach a stand-alone printing apparatus (MDPS 10 (column 4, lines 8-11)) for transferring one or more digital photographs captured by a digital device to a printable medium, the printing apparatus comprising an input member for receiving one or more digital photographs from a source (documents received from multifunctional local device 14 or remote device 16); image processing system for generating an image corresponding to each digital photograph (processing means 12 (column 4, lines 11-19)); an integrated user interface for selecting the photograph to be transferred to the printable medium (visual display device 18, keyboard 20 (column 4, lines 46-57)); and a print control for producing on the printable medium a pattern associated with the printing page, wherein the user interface is dynamically expandable (control module 22 (column 4, line 62 – column 5, line 21)). The image processing system is dynamically expandable in functionality through the utilization of one or more plug-in modules, and comprises at least one drive for receiving a computer readable medium comprising instructions for dynamically expanding the user interface, or comprising one or more

plug-in modules (column 4, line 67 – column 5, line 2). The plug-in modules comprise a sequence of instructions (note Figs. 4-8).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al. as applied to claim 9 above, and further in view of U.S. patent 5,543,925 (Timmermans). Claim 14 is also rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al. in view of Timmermans.

Hu et al. do not teach an ability to store setting and user selections on a removable storage memory media. However, Timmermans teaches a playback apparatus which utilizes a removable memory module 460 which is used for storing

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user-sourced picture parameter data (column 22, lines 5-39). This allows a user to save picture parameter data for future reproduction on the reproduction device, and for future playback on other playback devices (column 4, lines 25-30), thereby eliminating the need to manually input the parameter data for each reproduction. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Hu et al. by providing a removable memory module such as taught by Timmermans.

6. Claims 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al. as applied to claim 7 above, and further in view of U.S. Patent 6,012,070 (Cheng et al.).

Hu et al. do not an image processing system further comprising template definition and printing, wherein the template definition comprises one or more items selected from the group consisting of photo images, background art, images and text selections, or comprises the position, size and physical characteristics corresponding to the items. Cheng et al. teach a method for defining and printing templates, such as graphics, variable text and images (column 6, lines 36-57). The ability to manipulate the position, size and physical characteristics of the templates, while not mentioned by Cheng et al., is a well-known editing function that would have been an obvious modification to one of ordinary skill in the art. Providing template definition and printing allows a user to customizing documents more efficiently, and thus it would have been obvious for one of ordinary skill in the art to modify the teaching of Hu et al. by providing a method for defining and printing templates, as taught by Cheng et al.

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7. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al. in view of Timmermans as applied to claim 14 above, and further in view of Cheng et al.

The reasons for rejecting claim 15 are the same as set forth above with respect to claim 11.

8. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al. in view of U.S. Patent 5,339,172 (Robinson).

Claim 16 further recites an image processing system comprising the ability to independently enhance one or more images from each other on the same page. This feature, while not taught by Hu et al., is well known in the art. For example, Robinson teaches segmentation of an input image, and each segmented portion is enhanced independent of the enhancement of other portions (column 7, lines 7-30). Robinson realized that different types of images (high frequency, low frequency, line/text, continuous tone) needed to be enhanced using different methods so that none of the images appearing on a document are degraded. Therefore, it would have been obvious for one of ordinary skill in the art to modify the teaching of Hu et al. by allowing for independent enhancement of images as taught by Robinson.

9. Claim 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al. in view of Robinson as applied to claim 16 above, and further in view of Timmermans.

The reasons for rejecting claim 17 are the same as set forth above with respect to claim 10.

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10. Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hu et al. in view of Robinson as applied to claim 16 above, and further in view of Cheng et al.

The reasons for rejecting claims 18-20 are the same as set forth above with respect to claims 11-13, respectively.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas D. Lee whose telephone number is (703) 305-4870. The examiner can normally be reached on Monday-Friday (7:30-5:00), alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (703) 308-7452. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



Thomas D. Lee  
Primary Examiner  
Art Unit 2624

tdl  
May 30, 2002